

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN R. J. SORENSON

Appeal No. 1997-3047
Application 08/480,152

ON BRIEF

Before GARRIS, WARREN and OWENS, *Administrative Patent Judges*.
OWENS, *Administrative Patent Judge*.

ON REQUEST FOR REHEARING

Appellant requests reconsideration of our decision mailed on December 22, 2000, wherein we affirmed the rejections of claims 1-8 under the judicially created doctrine of obviousness-type double patenting over claims 1-9 of Sorenson '834 and over claims 1-8 of Sorenson '171. We treat this

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request as a request for rehearing under 37 CFR
§ 1.197(b)(1997).

Appellant argues that the examiner's January 15, 1976 restriction requirement established that the generic claim was separately patentable from the species claims (request, pages 2-3). What the examiner stated in the restriction requirement (pages 2-3) is that "[s]ince the various compounds embraced by the claims are not so related that a prior art reference anticipating the claims in respected [sic] to certain members would render the claims obvious in respect to other members, applicant is further, required to elect a single disclosed species and to list all claims readable thereon including claims subsequently added." This statement clearly pertains to separate patentability among the species, and not to separate patentability of the genus and any of the species therein, because a reference which anticipates a specie also anticipates a genus which encompasses that specie. See *In re Gosteli*, 872 F.2d 1008, 1010, 10 USPQ2d 1614, 1616 (Fed. Cir. 1989).

Appellant argues that consonance is not an absolute requirement for 35 U.S.C. § 121 to apply (request, page 3). Appellant relies upon *Applied Materials Inc. v. Advanced Semiconductor Materials*, 98 F.3d 1563, 1568, 40 USPQ2d 1481, 1484 (Fed. Cir. 1996), wherein the majority stated that "even if such consonance [i.e., demarcation among the separate inventions] is lost, double patenting does not follow if the requirements of § 121 are met or if the claims are in fact patentably distinct."¹ Section 121 requires that inventions which are restricted from each other must be independent and distinct from each other. As explained in our decision (pages 5-6), the generic claims in the present case are not independent and distinct from the claims in Sorenson '834 or Sorenson '171. Appellant, therefore, is not entitled to the benefit of 35 U.S.C. § 121.

Appellant argues that *Eli Lilly & Co. v. Barr Labs. Inc.*,

¹ In a dissent-in-part, Judge Archer, citing *Gerber Garment Technology, Inc. v. Lectra Sys.*, 916 F.2d 683, 688, 16 USPQ2d 1436, 1440 (Fed. Cir. 1990), stated that "[t]his court has ruled, however, that the protection of § 121 is only available for claims issued on a divisional application that are consonant with the examiner's restriction requirement." *Applied Materials*, 98 F.3d at 1577, 40 USPQ2d at 1492.

222 F.3d 973, 987, 55 USPQ2d 1609, 1619 (Fed. Cir. 2000), relied upon by the board (decision, pages 8-9), is contrary to prior controlling law (request, pages 3-4). Appellant argues that *In re Stanley*, 214 F.2d 151, 102 USPQ 234 (CCPA 1954) indicates that mere dominance by generic claims is not decisive (request, page 4). In *Stanley*, the Truitt patent had the same assignee as the appellant's application, was based upon an application filed more than two years after the appellant's application was filed, and contained claims which were limited to an improvement over the appellant's generic claims. *Stanley*, 214 F.2d at 152 and 158, 102 USPQ at 235 and 240. The court in *Stanley*, 214 F.2d at 156, 102 USPQ at 238, citing *In re Mann*, 47 F.2d 370, 8 USPQ 381 (CCPA 1931), noted what it called an exception to the obviousness-type double patenting rejection:

In certain cases, where there are two applications by different inventors, but held by a common assignee, and there is a disclosure of the same basic invention in both applications, but in one of which it is asserted that the applicant is the inventor only of an improvement in the basic invention disclosed, a patent issued upon the improvement claim [sic] in such last named application is not a bar to a patent upon the other application....

The court in *Stanley* stated:

We are of the opinion that the generic invention is not rendered unpatentable by the fact that a prior patent has been issued on a distinct improvement of that invention. We think this appeal clearly comes within the exception set out in the Mann and Koppleman case, *supra*, since none of the appealed claims could have been made on the Truitt disclosure, nor do both applications disclose the *same invention*. Further, we think that the appellants should not be denied a patent for their invention because of the specific improvement patent to Truitt merely on the basis of the common assignee.

Stanley, 214 F.2d at 159, 102 USPQ at 240.

The court in *Stanley* discussed *Thomson-Houston Electric Co. v. Ohio Brass Co.*, 80 F. 712 (6th Cir. 1897), which is relied upon by appellant (request, pages 3-4). The *Stanley* court stated that in *Thomson-Houston*, the court held that the '451 patent, which was drawn to distinct and specific structural improvements in the device claimed in the '695 patent which was based on an application filed more than a year before the filing of the application which led to the first-to-issue '451 patent, did not render the '695 patent invalid. See *Stanley*, 214 F.2d at 154-55, 102 USPQ at 237. Thus, the facts in *Thomson-Houston* were comparable to those in

Stanley, and the decisions in these cases were consistent with each other.

The facts in *Lilly*, however, were quite different from the facts in *Stanley* and *Thomson-Houston*. In *Lilly*, claim 1 of the '895 patent recited treating depression in humans by administering a compound within a genus which included fluoxetine hydrochloride, and claim 7 of the '549 patent recited administering fluoxetine hydrochloride to an animal to block serotonin uptake in the animal's brain neurons. See *Lilly*, 222 F.3d at 978-79, 55 USPQ2d at 1612-13. The applications which led to the '895 and '549 patents were filed, respectively, on September 17, 1975 and March 31, 1986, and issued, respectively, on April 19, 1977 and December 2, 1986. According to the court, both claimed benefit under 35 U.S.C. § 120 of the filing date of an application filed in 1974. See *Lilly*, 222 F.3d at 978-79, 55 USPQ2d at 1612-13. The court stated that "[t]hroughout the term of the '895 patent, by virtue of claim 1's broad coverage, Lilly possessed the right to exclude other parties from administering any of the thousands of claimed compounds, including but not limited

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to fluoxetine hydrochloride, to treat depression." See *Lilly*,
222 F.3d at 986-87, 55 USPQ2d at 1618. According to the
court:

The only discernible difference between claim 1 of
the '895 patent and claim 7 of the '549 patent is
that the former addresses the treatment of
depression in humans while the latter addresses the
treatment of serotonin uptake in animals. Humans
are a species of the animal genus, and depression is
a species ailment of the genus of ailments caused by
defective serotonin uptake. Our case law firmly
establishes that a later genus claim is not
patentable over an earlier species claim.

Lilly, 222 F.3d 987, 55 USPQ2d 1619.

Thus, contrary to appellant's argument, *Lilly* is not
inconsistent with *Stanley* and *Thomson-Houston*. *Stanley* and
Thomson-Houston involved the situation in which a later filed
application claiming a specie within a genus issues before an
earlier filed application which claims the genus. In both of
those cases, the courts held that the specie claims could not
be used to reject claims to the genus in an obviousness-type
double patenting rejection. The court in *Stanley* indicated
that prior courts applied a two-way test for obviousness-type
double patenting in such a situation. See *Stanley*, 214 F.2d
at 155, 102 F.2d 238. Appellant in the present case has not

argued that a two-way test should be used. *Lilly*, on the other hand, involved the situation in which two patents have the same effective filing date, the first filed and issued application claims a specie and the later filed application claims a genus. The court held that in that situation the later genus claim is unpatentable under the doctrine of obviousness-type double patenting over the earlier specie claim.

The present case is similar to *Lilly* in that the Sorenson references and the present application have the same effective filing date, the earlier filed and issued Sorenson patents claim species, and the present application claims a genus which encompasses the species. In the present case it is the compositions themselves which have a specie-genus relationship, rather than the uses having that relationship as in *Lilly*. As explained in *Lilly* and the cases relied upon therein, in such a situation the genus is considered to be unpatentable over the specie under the doctrine of obviousness-type double patenting. See *Lilly*, 222 F.3d at 987, 55 USPQ2d at 1619.

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In response to appellant's request, we have reconsidered our decision. However, for the above reasons, we decline to make any change thereto.

DENIED

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BRADLEY R. GARRIS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES F. WARREN)	
Administrative Patent Judge)	APPEALS AND
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)	
TERRY J. OWENS)	
Administrative Patent Judge)	

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